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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,080	07/25/2003	Joachim Wolf	331.1048	3127
23280	7590	09/18/2006	EXAMINER	
DAVIDSON, DAVIDSON & KAPPEL, LLC 485 SEVENTH AVENUE, 14TH FLOOR NEW YORK, NY 10018			PICKARD, ALISON K	
			ART UNIT	PAPER NUMBER
			3673	
DATE MAILED: 09/18/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/627,080

Applicant(s)

WOLF ET AL.

Examiner

Alison K. Pickard

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6,8-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,8-13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Upon further consideration, the allowability of claim 13 has been withdrawn. The examiner regrets any inconvenience this may cause.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-3, 6, 8-12, 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to provide support for an axle boot having compensating pieces joined to one another by ring sections to form a single piece component AND a clamp, and further where the clamp is then integrated with the one-piece component to form a multi-component unit. It appears that there are two embodiments set forth. One relates to the pieces joined by ring sections and one relates to the pieces being joined to a clamp.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-3 and 8-12 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker in view of Devers.

Baker discloses an axle boot comprising a joint housing 16 having plural radial recesses 16b and a bellows 12. The bellows is made of TPE and has an integral connecting collar 15 including a plurality of indentations projecting radially inward and adapted to recesses 16b (see Fig. 2 and col. 3, lines 62-65). A plurality of compensating pieces 22 is attached to an outer surface of the collar to form a cylindrical outer circumference for a clamp 23. The pieces are all connected and include ring sections (near 22) to connect adjacent pieces. The projecting portion of the pieces has a length corresponding to the recess.

Baker does not disclose ring sections wherein at least one ring section is elastically deformable, that the pieces are made of more than one material, or that the pieces have a web. Devers teaches an axle boot having a joint housing and bellows. Devers teaches a plurality of compensating pieces with the bellows. The pieces are connected as a single piece component having ring sections (near 32), wherein at least one is elastically deformable (see col. 4, line 12), which allows the component to be installed. Devers also teaches the compensating pieces include more than one material (i.e. insert 44 is a harder material than the rest of element 40). The pieces are a hollow (air-filled) body having flexible walls/ webs (e.g. Fig. 7). Devers teaches that this compensating component provides a more uniform stiffness and compression, thus providing a more uniform sealing and clamping force. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the compensating component of Baker with the unified component taught by Devers to provide a more uniform sealing and clamping force.

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5. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '464.

JP '464 discloses a boot comprising a joint housing including an external contour with radial recesses. A bellows has a collar with plural indentations (e.g. 26) adapted to the recesses. A clamp 11 or 27 with integrated connecting pieces 28 or 14 is disposed around the collar to form a cylindrical outer surface. It is not clear if the pieces are connected to the collar via a rivet. The examiner takes Official Notice that it is well known to one of ordinary skill in the art to use a rivet as a means to connect two pieces. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use a rivet to connect the collar and piece with a rivet.

6. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '464 as applied to claim 13 above, and further in view of Devers.

Devers teaches an axle boot having a joint housing and bellows. Devers teaches a plurality of compensating pieces with the bellows. Devers also teaches the compensating pieces include more than one material (i.e. insert 44 is a harder material than the rest of element 40). The pieces are a hollow (air-filled) body having flexible walls/ webs (e.g. Fig. 7). Devers teaches that this compensating component provides a more uniform stiffness and compression, thus providing a more uniform sealing and clamping force. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the compensating pieces of JP '464 with the pieces taught by Devers to provide a more uniform sealing and clamping force.

Allowable Subject Matter

7. Claim 6 has allowable subject matter, but is currently rejected under 112 1st paragraph.

Response to Arguments

8. Applicant's arguments filed 6-26-06 have been fully considered but they are not persuasive.

The 112 first paragraph rejections have been maintained. Paragraph 0031 does not provide adequate support for the claimed embodiments. Based on Applicant's specification there are two main embodiments. One includes a clamp with pieces riveted to it. The other includes pieces joined by "ring sections" (with at least one being elastically deformable). There is NO disclosure of an embodiment with pieces joined by ring sections and then further integrated with an additional clamp as a multi-component unit. The "clamp" referred to in the specification is the band that the pieces are riveted to (i.e. in the one embodiment). In the other embodiment, there is no mention of a "clamp", although it appears the ring sections and integral pieces would comprise an integrated sort of "clamp."


The rejection of Baker in view of Devers has also been maintained. The argument that Baker's segments are "individually" free to move is unpersuasive since Baker discloses the segments are tack welded and secured by the clamp. Also, disadvantages discussed by Baker's background are not related to a unitary band, such as that taught by Devers. Devers would provide a uniform outer diameter to transmit clamping forces. More importantly, it has been held that the use of one-piece construction is obvious. See *In re Larson* 144 USPQ 347, 348 (CCPA 1965).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Alison K. Pickard
Primary Examiner
Art Unit 3673

AP